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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,845	07/29/2005	Terje Angelskaar	MBZ-0503	4363
23575 7590 09/15/2008 CURATOLO SIDOTI CO., LPA 24500 CENTER RIDGE ROAD, SUITE 280 CLEVELAND, OH 44145				
EXAMINER				
GOLOBOY, JAMES C				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
09/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,845

Applicant(s)

ANGELSKAAR, TERJE

Examiner

James Goloboy

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date 2/7/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 18 recite a composition that dissolves in water "within about 60 seconds". However, the speed at which the composition dissolves will depend on factors such as the temperature of the water, and whether the mixture is stirred. It is not clear under which conditions the recited composition is supposed to dissolve in water within about 60 seconds. Similarly, the pH of the solution will depend on the concentration of the composition, which is not specified in the claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 2, 7-10, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto (JP-5821489A) in view of Grier (U.S. Pat. No. 4,149,983) and Jonnes (U.S. Pat. No. 4,461,712).

An English translation of Matsumoto, which is attached, has been used in setting forth this rejection. The page and line numbers of Matsumoto referred to in this rejection are based on the translation.

On page 4 lines 16-20, Matsumoto discloses an aqueous metalworking lubricant comprising bicarbonate (hydrogen carbonate) and a surfactant. On page 6 lines 23-24 Matsumoto discloses that the bicarbonate can be an alkali metal carbonate, as recited in claims 2 and 14, and can be sodium bicarbonate, as recited in claims 7 and 15. The range of possible concentrations of bicarbonate as a percentage of the solid lubricating composition is from 25 to 98% by weight, encompassing the range recited in claim 2. The range of possible concentrations of surfactant is 1.5 to 28%, overlapping the range recited in claim 2. On page 16, lines 13-16, Matsumoto discloses two sample compositions (Lubricants B and C) where the concentration of sodium bicarbonate is

85% by weight of the solid components and the concentration of surfactant is 2.8% by weight of the solid components, both within the range recited in claim 2.

The differences between Matsumoto and the currently presented claims are:

i) Matsumoto discloses a surfactant, but does not disclose a sodium lauryl sulfate surfactant. This relates to claims 2, 8, 14, and 16.

ii) Matsumoto does not disclose the addition of polyethylene oxide to the composition. This relates to claims 2, 9, 14, and 17.

With respect to i), Grier discloses in column 2 lines 26-65 aqueous metalworking fluids containing a surfactant. In column 3 lines 11-12 and column 4 line 36, Grier discloses that sodium lauryl sulfate, as recited in claims 8 and 16 and meeting the limitations of the surfactants of claims 2 and 14, is a suitable surfactant.

With respect to ii), Jonnes discloses in the abstract an aqueous lubricant containing a polyalkylene oxide compound. In column 3 lines 38-40 Jonnes discloses that the polyalkylene oxide is most preferably polyethylene oxide with a molecular weight of 2,000,000 to 6,000,000, meeting the limitations of the polyethylene oxide of claims 2, 9, 14, and 17. In column 5 lines 11-12 Jonnes discloses that the polyethylene oxide is effective in a concentration of 0.05 to 10 parts by weight of the overall composition, leading to a concentration of polyethylene oxide relative to the total solid composition overlapping the range recited in claim 2.

It would have been obvious to one of ordinary skill in the art to use the surfactant of Grier as the surfactant in the composition of Matsumoto, as Grier teaches that it is a suitable surfactant for use in an aqueous metalworking fluid. It would have been obvious

to one of ordinary skill in the art to include the polyethylene oxide of Jonnes in the composition of Matsumoto, as Jonnes teaches in column 3 lines 44-48 that polyethylene oxide imparts several advantages to aqueous lubricants, including improved lubricity and low toxicity.

While Matsumoto, Grier, and Jonnes do not disclose the pH of the aqueous solution containing the lubricant mixture, it is the examiner's position that as the mixture contains the same components as the claimed composition, it will produce an aqueous solution with the same pH.

6. Claims 3 and 11-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto in view of Grier and Jonnes as applied to claims 2, 7-9, and 14-17 above, and further in view of Kuwamoto (JP 60-001291A).

An English abstract of Kuwamoto, which is included, has been used in setting forth this rejection.

The discussion of Matsumoto, Grier, and Jonnes in paragraph 5 above is incorporated here by reference. Matsumoto, Grier, and Jonnes disclose an aqueous-based metalworking lubricant meeting the limitations of claim 2 and further containing 1 to 2% by weight of a dispersant, but do not disclose the specific dispersants of claims 3 and 11-13.

Kuwamoto, in the abstract, discloses an aqueous-based metalworking (rolling) fluid, and teaches that the composition contains a dispersant. Kuwamoto teaches that the dispersant can be a salt of aminotrimethylenephosphonic acid, as recited in claim

12, or carboxylic acids such as tartaric acid, meeting the limitations of claim 11. When the salts are dissolved, they will dissociate and the acids will be present in the composition. The use of the dispersants of Kuwamoto in the composition of Matsumoto, Grier, and Jonnes therefore meets the limitations of claims 3 and 11-13.

It would have been obvious to one of ordinary skill in the art to use the dispersants of Kuwamoto in the composition of Matsumoto, Grier, and Jonnes, as Kuwamoto teaches that they are suitable dispersants for metalworking fluids.

7. Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davidsson (U.S. Pat. No. 5,318,408) in view of Matsumoto, Grier, and Jonnes.

Davidsson, in column 1 lines 5-7, discloses a lubricating suspension for concrete pipes, pumps, and hoses. In column 1, Davidsson discusses problems with traditional cement slurries used to lubricate the pipes. In column 2 lines 31-50 Davidsson discloses that aqueous suspensions are preferable lubricants.

The discussion of Matsumoto, Grier, and Jonnes in paragraph 5 above is incorporated here by reference. Matsumoto, Grier, and Jonnes disclose an aqueous lubricant useful for metal tubes. The use of the composition of Matsumoto, Grier, and Jonnes as an aqueous lubricant for cement-carrying pipes meets the limitations of claims 1 and 4-6, and would have been obvious to one of ordinary skill in the art in the case where the cement-carrying pipes are made of metal, as Matsumoto teaches that the composition is effective in lubricating metal tubes.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797